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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,381	02/28/2002	Michael Maker	7200	6267

7590

09/09/2004

SHLESINGER, ARKWRIGHT & GARVEY LLP
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EXAMINER

MUSSER, BARBARA J

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/084,381	Applicant(s) MAKER ET AL.	
	Examiner Barbara J. Musser	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/19/04</u> | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 7, the claim appears to be missing a step. While there is no missing step number, the claim skips from forming the positive pattern on the outside of the auxiliary roller to removing the embossing copy formed from the pattern with no step of forming the embossing copy using the pattern. It appears that step (e) of claim 1 was inadvertently left out of claim 7, and for the purposes of examination, it is assumed this step is part of claim 7.

3. Claim 7 recites the limitation "the embossing copy" in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1733

5. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minke et al.(DE 4324970A1), Goto et al.(U.S. Patent 5,397,417), and Hallam et al.(GB 1,063,154)

DE 4324970A1, having a common inventor with the application, discloses a method of forming an embossing roller by etching a roller having a smooth plastic film surface with a laser which moves along the surface of the roller and is controlled such that it forms a desired pattern on the roller surface. A uniform layer of silicone rubber is then applied to the patterned surface and vulcanized. It is then removed from the roller, inverted, and bonded to a different roller to form an embossing roller. The laser is modulated in accordance corresponding electrical information obtained by scanning the original pattern.(English Abstract, Oral translation) The reference does not specifically disclose the surface of the roller is smooth, but it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the surface of the roller smooth before laser etching as this would require destruction of less material and to control the movement of the laser to be congruent with a pattern in its memory as this would allow cutting of a pattern in an automated way.

Minke et al. does not disclose the material forming the patterned surface is nitrile butadiene rubber but does disclose it is a plastic material. Goto et al. discloses cutting a design into a sheet of nitrile butadiene rubber using a laser.(Col. 4, ll. 49-50; Col. 5, ll. 49-51) It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the material used to form the patterned layer from any conventional type of material which can be cut by a laser such as nitrile butadiene

Art Unit: 1733

rubber since Goto et al. discloses nitrile butadiene rubber can be cut by a laser and since it would have been obvious to use an elastomeric material to make it easier to remove the rubber layer from the patterned surface particularly since Hallam et al. discloses it is known to use nitrile rollers for printing patterns.(Pg. 1, ll. 11-14, 32-40)

Regarding claim 8, Minke et al. discloses forming a grain pattern.(Abstract)

Information Disclosure Statement

DE 1985962, previously marked through, has been placed on a PTO 892 so that it is shown as having been considered as the scanned marked through version of the PTO 1449 is the only copy available and therefore the marking cannot be removed.

Response to Arguments

6. Applicant's arguments filed 5/19/04 have been fully considered but they are not persuasive.

Regarding applicant's argument that the combination of references do not teach the claimed invention, they appear to teach all the steps of the claim.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara J. Musser whose telephone number is (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571)-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 10/084,381

Page 6

Art Unit: 1733

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BJM


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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700